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Application No.: 10/053,402
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Jeffrey G. Anderson, et al.

Confirmation No.: **1590**

Application No.: **10/053,402**

Group Art Unit: **2151**

Filing Date: **January 17, 2002**

Examiner: **Karen C. Tang**

For: **Local Agent For Remote File Access System**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

I. Reasons for Review

Withdrawal of the Final Rejection, dated 5/2/2007, is believed appropriate because the Examiner erred by combining two references such that their combination changes the principle of operation of the primary reference as prohibited per MPEP §2143.01 Part VI. Accordingly, the combination of references is not sufficient to render the claims *prima facie* obvious under 35 USC §103(a).

II. Status of Prosecution

Claims 1-20 and 25-33 are pending in the Application. Claims 25-30 are withdrawn from consideration via restriction. Claims 1-20 and 31-33 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0023140 to Hile et al. (referred to hereafter as Hile) in view of U.S. Patent Publication No. 2005/0283462 to Pennec et al. (referred to hereafter as Pennec).

III. No *prima facie* case of obviousness using the cited references.

The teachings of the combination of references of Hile and Pennec are not sufficient to render the claims *prima facie* obvious per MPEP §2143.01 Part VI because the addition of Pennec to Hile impermissibly changes the principle of operation of Hile. Pennec prohibits direct client to server communications upon which Hile relies for operation. Thus, the modification of Pennec renders Hile inoperative by changing Hile's principle of operation.

MPEP §2143.01 Part VI states that a proposed modification cannot change the principle of operation of a reference in a 35 USC §103 rejection. Specifically, MPEP §2143.01 Part VI states: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."

Hile teaches a Electronic Document Delivery System having a method "for transferring data files between a first computing device and a second computing device interconnected by a network. The method includes: establishing a first network connection between the first computing device and a second computing device; registering a file transfer request for a given data file with a server application residing on the second computing device; establishing a second network connection between the first computing device and the

second computing device, such that the second network connection is independent from the first network connection; retrieving the file transfer request from the server application via the second network connection; and transferring the data file via the second network connection in response to the file transfer request retrieved from the server application.”

(See Hile, paragraph 0005)

Hile teaches a direct communication from the user-requesting application to register requests for document deliveries that are pushed from the user computer to a server. Hile, Figure 3, teaches a file transfer is initiated by a user that wishes to send a file to another computer by having a user fill out a file “Send Form” to an application server (see Figure 3, items 42-56). As stated in paragraph 0018 of Hile:

“To schedule or register a file transfer, the user fills in the Send form 50. In particular, the user enters an email address for the recipient of the file and selects the file or files they wish to send.” (Hile, paragraph 0018).

As stated in paragraph 0019 of Hile:

“Next, the selected file must be transferred from the sender's computing device to the server.” (Hile, paragraph 0019)

Accordingly, Hile teaches using a direct communication between a user-requesting application and a server application to register a file transfer request. The transfer pushes a file from a user/client to another entity on a network. Applicant notes that Hile does not teach using a “task request generated by a remote client computer, the task request requesting a file from the local computer” as recited in independent Claims, 1, 8, and 15. The present claims recite requesting a file whereas Hile teaches sending a file (see Hile, paragraphs 0018-0019). Page 3 the Final Office Action dated 5/2/07 agrees that Hile is silent regarding the above-mentioned pending claim element.

Pennec discloses a method and system which comprises receiving a request for the file, where the request comprises data identifying the remote server, checking that the file is locally stored, forwarding the file to the remote server when the file has been locally modified, and deleting the information according to which said file is locally stored. (See Pennec, Abstract) One function offered by Pennec is the transfer of a requested file to a client. However, Pennec places a restriction in operation of the system and method. Pennec paragraph 0036 teaches that the configuration does not allow direct file transfers between the

Client and the Home File Server. Pennec teaches:

“There is no direct exchange between the client 400 and the home server 402.”

(Pennec, paragraph 0036).

Since Pennec does not allow direct client to server file transfers, and Hile relies on a direct communication between the user and the server to register requests to deliver files from a user to some destination, then the addition of Pennec to Hile impermissibly changes the principle of operation of Hile because Pennec forces the Hile method to avoid direct user to server transactions upon which Hile relies. Since the addition of the teachings of Pennec to the teachings of Hile changes the principle of operation of Hile by forcing Hile to avoid direct user to server communications, then, according to MPEP §2143.01 Part VI, the teachings of the references are “not sufficient to render the claims of the present application prima facie obvious”. Thus, there is no motivation to combine Hile and Pennec.

If Hile were modified per Pennec, then direct user to server requests for file deliveries would be disallowed because Pennec does not allow direct client to home server transactions. With this modification, Hile would never receive file push delivery requests. The result is that Hile is rendered inoperable under the influence of Pennec because Hile relies on direct client (user) to server communications to register a file delivery request. Since Pennec modifies Hile to prohibit direct client to server communications, then Hile is rendered inoperative when combined with Pennec.

IV. No substantive reason is provided for the dismissal of MPEP §2143.03 Part VI.

The Advisory Action dated 6/18/2007 states:

“Hile indicated on the paragraph 0031 that the invention is capable of modification without departing from the spirit of the invention. Hile and Pennec both are concentrate their inventions on file transferring, therefore the combination of the two references would not depart from the spirit of Hile's invention. Further, it is obvious that if one party started to request the file transfer first in Hile, then the second party would start transferring file by request. Therefore, it makes sense to combine the two references.”

(Advisory Action, dated 6/18/07, page 2)

Applicant respectfully notes that paragraph 0031 states, in full: “While the invention has been described in its presently preferred form, it will be understood that the invention is

capable of modification without departing from the spirit of the invention *as set forth in the appended claims.*” Applicant notes that the independent claims of Hile include establishing a first network connection between the first computing device and a server which is prohibited by Pennec.

Neither the Final Office Action nor the Advisory Action present a reason why MPEP §2143.03 Part VI may be dismissed in this instance. Under the current combination of Hile and Pennec, the principle of operation of Hile is changed by the addition of Pennec to the point of inoperability of Hile. As such, the combination of Hile and Pennec is disallowed under the MPEP, and yet, the current 35 USC §103(a) rejection is maintained without expressed reason as to why the specific MPEP §2143.03 Part VI rule should be ignored for this case.

Applicant respectfully submits that the current 35 U.S. C. §103 (a) rejection of all pending claims does not represent a valid prima facie case of obviousness because the combination is impermissible according to MPEP §2143.01 Part VI. Thus, the pending 35 USC §103 (a) rejection should be withdrawn. Applicant earnestly requests reconsideration of all pending claims and withdrawal of the current impermissible 35 USC §103(a) rejection.

Respectfully submitted,

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